REMARKS/ARGUMENTS

Applicants have received the Office Action dated March 31, 2005, in which the Examiner: (1) objected to claims 5 and 14; and (2) rejected claims 1-18 as obvious over Cortes (U.S. Pat. No. 6,480,844) in view of Scroggie (U.S. Pat. No. 5,970,469). Applicants amend claims 5 and 14. Based on the arguments and amendments contained herein, Applicants respectfully traverse the rejections.

The Examiner objected to claims 5 and 14. Those claims contain a model description that has typographical errors. These claims and the corresponding description in the specification have been amended.

Cortes is directed to a method for determining whether a telephone line is being used for residential or business purposes—a determination that may not be quite so apparent in the case of, for example, a home phone line being for business purposes. Cortes disclosing analyzing various pieces of information such as the frequency of calls during normal business hours versus after hours, the types of phone numbers (e.g., 800 numbers) calling the line in question, the connect time of calls to that line, the duration of calls to the line, etc. See e.g., cols. 6 and 7. Cortes specifically states that "customer identification" is not used in the calculus. Col. 6, lines 52-53.

Scroggie relates to a method for providing shopping aids (e.g., incentives such as coupons) via computer network. Col. 1, lines 26-43. Scroggie does not disclose modeling anything.

Claim 1 is directed to a "method for predicting whether an on-line shopper is converted into becoming a purchaser." The claim requires storing information including "profile" and "log" information about the on-line shoppers as well as "product information" and "promotion attributes" corresponding to the products. The claim further requires "constructing a model which simulates shopping behavior" as a function of at least the four types of information listed above. A "percentage change" is generated that the customer purchases a particular item based on the constructed model.

The Examiner concluded that Cortes does not disclose "that the database files are specifically for online shoppers, that their habits are logged, or that the database contains product information and incentives." To be sure, Cortes does not disclose a number of claim limitations. For instance, Cortes does not disclose customer profile and log information pertaining to on-line shoppers. Cortes advocates away from using customer identifications. Applicants do not find in Cortes any teaching of log information regarding the network log-on behavior of an on-line shopper. Cortes, as the Examiner recognized, is unrelated to on-line shopping.

Cortes also fails to disclose "constructing a model which simulates shopping behavior." Certainly Cortes fails to disclose "constructing a model which simulates shopping behavior as a function of the customer profile information, customer log information, product information, and promotion attributes." To the extent Cortes discloses constructing a model, such a model certainly is not one that simulates the behavior of on-line shoppers and certainly is not a model based on the four types of information recited in the claim.

Cortes does not disclose generating a percentage chance a customer purchases an item based on the model. Cortes does not relate to on-line shopping and does not disclose generating a percentage chance that a customer will buy something.

Scroggie does not solve the deficiencies of Cortes. Scroggie does not appear to disclose constructing any models whatsoever. Scroggie does not advocate the use of any customer or product-related information in the construction of a model of shopping behavior.

The Examiner has not established a legally sufficient basis to combine Scroggie with Cortes. The Federal Circuit has clearly articulated the law regarding the use of prior art references in an obviousness analysis. "35 U.S.C. § 103 requires that obviousness be determined with respect to the invention as a whole... This is essential for combination inventions, for generally all combinations are of known elements." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). Further, [i]t is impermissible to use the claimed

invention as an instruction manual or "template" to piece together the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (reversing examiner's rejection). As such, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*

The Examiner states in the Office Action that it would have been obvious to combine the references "because the results would provide a model for predicting online shopping behavior, thereby maximizing profits." The Examiner fails to explain how combining the teachings of Scroggie into Cortes would result in a model that predicts on-line shopping in a way that maximizes profit. Neither reference even teaches generating a model to predict online shopping behavior. At any rate, if the result of "maximizing profits" is sufficient to justify combining two references together, then how could an inventor ever patent his or her profit-maximizing contribution? The very reason for the inventor conceiving of the invention in the first place would, in effect, be used against the inventor.

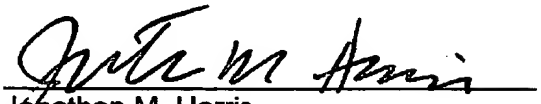
For any or all of these reasons, claim 1 is patentable. At least for the same reason as claim 1, claims 2-9 are allowable as well. Independent claim 10 and its dependent claims are allowable at least for the same reasons as claim 1.

The Examiner apparently has taken "official notice" that certain limitations of various dependent claims are well-known in the art. Because it is believed that the rejections of the independent claims are in error, Applicants opt not to address the official notice taken by the Examiner. At this time, Applicants take no position on whether or not the Examiner is correct in what the Examiner believes is well-known in the art.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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